

REMARKS

The Applicant has received and reviewed the Office Action dated August 24, 2005 wherein the Office rejected claims 1-6 and claims 8-9 and 11-12 "... under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 (Landes) in view of Stuart (US Patent No. 6,461,084) and further in view of Ebinger (U.S. Patent No. 3,709,112)."

Rejection under 35 U.S.C. 103(a)

Under obviousness-type double patenting

Applicant's claims 1-6 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 (Landes) in view of Stuart (US Patent No. 6,461,084) and further in view of Ebinger (U.S. Patent No. 3,709,112). Applicant's claims 8-9 and 11-12 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 (Landes) in view of Stuart (US Patent No. 6,461,084) and further in view of Ebinger (U.S. Patent No. 3,709,112).

The Applicant strenuously disagrees with the Office's above rejection of the Applicant's claims based on the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,099,203 in view of Stuart and further in view of Ebinger for the following reasons.

**I. It would not have been obvious to combine
claims 1-5 of U.S. Patent No. 6,099,203, and Ebinger**

Applicant's independent claim 1 calls for a marker post including:

“... a first integral anchoring flap, said anchoring flap having a first end and a second end, said anchoring flap located proximate the second end of said one-piece hollow elongated member; and ... a first flexible living hinge, said anchoring flap attached to the one-piece hollow elongated member at the second end of said anchoring flap by said first flexible living hinge, said anchoring flap moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said one-piece hollow elongated member from an embedded position and vice versa.”

Applicant's independent claim 8 calls for a hollow anchoring marker post including:

“...a first anchoring flap, a second anchoring flap, and a third anchoring flap, each of said anchoring flaps having a first end and a second end, each of said anchoring flaps integrally connected to said one-piece triangular shaped elongated member, each of said anchoring flaps located on said one-piece triangular shaped elongated member proximate a the second end of said one-piece triangular shaped elongated member; and”

“...a first flexible living hinge, a second flexible living hinge, and a third flexible living hinge; the second end of said first anchoring flap attached to the first panel of said one-piece triangular shaped elongated member by said first flexible living hinge, the second end of said second anchoring flap attached to the second panel of said one-piece triangular shaped elongated member by said second flexible living hinge, the second end of said third anchoring flap attached to the third panel of said one-piece triangular shaped elongated member by said third flexible living hinge, each of said anchoring flaps moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said one-piece triangular shaped elongated member from an embedded position and vice versa whereby the flaps has a sufficient memory to stay in the open position until the post can be embedded.”

The Applicant respectfully submits that it would not have been obvious to combine the teaching of claims 1-5 of U.S. Patent No. 6,099,203 with the reference of Stuart (US Patent

No. 6,461,084) and the reference of Ebinger (U.S. Patent No. 3,709,112) to make Applicant's claims 1 and 11 obvious.

In regards to the cited references U.S. Patent No. 6,099,203, Stuart, and Ebinger, note that claims 1-5 of U.S. Patent 6,099,203 teaches a hollow resilient one piece marker post having:

"... a first integral web extending from said first panel to said second panel ... a second integral web extending from said second panel to said third panel ... and a third integral web extending from said third panel to said first panel ... to provide resiliency to said marker post so that when said marker post is bent by an object, the marker post can return to its original condition when the object is removed." (Emphasis added.)

However, as noted by the Office on page 3, lines 16-20, page 4, lines 1-9 and page 7, lines 1-14 of the Office Action, claims 1-5 of U.S. Patent No. 6,099,203 does not teach the above feature of Applicant's independent claims 1 and 8.

In regards to the reference of Ebinger, the reference of Ebinger teaches a one-piece device comprising:

"... a road guide post consisting of plastic material and having over its whole length a hollow tubular shape ..." (Emphasis added, column 1, lines 51-54.)

Note however that the reference of Ebinger also does not teach the above feature of Applicant's independent claims 1 and 8.

In regards to the reference of Stuart, the reference of Stuart teaches a three-part device comprising a post 2, a ground engaging portion 1 and collets 4 (column 2, lines 1-34) wherein the:

"... ground engaging portion is suitably a stake formed from pressed metal fins that are welded together..." (Emphasis added, see column 2, lines 10-11)

or is form by:

"... laser cut from a single sheet of metal or punched from a coil of metal ..." (column 3, lines 34-40, emphasis added).

a. Combination of the teachings of claims 1-5 of U.S. Patent No. 6,099,203 and Stuart

In regards to the combination of the teaching of claims 1-5 of U.S. Patent No. 6,099,203 with the reference of Stuart, the Applicant respectfully submits that by calling for a hollow resilient one piece marker post, that claims 1-5 of U.S. Patent No. 6,099,203 teaches away from Stuart's three-piece device comprising a post 2, a ground engaging portion 1 and collets.

The Applicant submits that by calling for a hollow resilient one piece marker post that claims 1-5 of U.S. Patent No. 6,099,203 also teaches away from Stuart's three-piece device wherein the ground engaging portion 1 is formed from metal, which is not a resilient material. (See column 2, lines 10-11 of Stuart.) The Applicant submits that claims 1-5 of U.S. Patent No. 6,099,203 further teaches away from the reference of Stuart by also calling for a hollow resilient one piece marker post that

provides "...resiliency to said marker post so that when said marker post is bent by an object, the marker post can return to its original condition when the object is removed" whereas Stuart discloses a post that is specifically secured to Stuart's embedded member 1 thereby allowing the post to be easily replaced if damaged such as by the impact of a vehicle (column 1, lines 20-21 and column 4, lines 56-58).

In further regards to the above, it is further submitted that the presence of the "integral web" claims 1-5 of U.S. Patent No. 6,099,203 teaches away from the metal deflectable portions 11 located on and integral to Stuart's fin 1a.

b. Combination of the teachings of claims 1-5 of U.S. Patent No. 6,099,203 and Stuart, and Ebinger

In regards to the combination of the teachings of claims 1-5 of U.S. Patent No. 6,099,203 and Stuart, and Ebinger, the Applicant notes that similar to claims 1-5 of U.S. Patent No. 6,099,203, the reference of Ebinger does not teach the above feature of Applicant's independent claims 1 and 8.

In regards to the combination of Stuart and Ebinger, the Applicant respectfully submits that by disclosing a one-piece device comprising a road guide post that the reference of Ebinger teaches away from Stuart's three-piece device comprising a post 2, a ground engaging portion 1. The Applicant also submits that by disclosing a one-piece device comprising a road guide post consisting of plastic material that the reference of Ebinger also teaches away from

Stuart's three-piece device comprising a post 2, a ground engaging portion 1 and collets wherein the ground engaging portion 1 is formed from metal.

The Applicant further submits that the reference of Ebinger further teaches away from the reference of Stuart as Ebinger discloses a partially embedded guide post that has the ability to right itself when repeatedly struck (column 1, lines 66-67) whereas Stuart discloses a post that is specifically secured to Stuart's embedded member (i.e. the post is located above the ground) thereby allowing the post to be easily replaced if damaged such as by the impact of a vehicle (column 1, lines 20-21 and column 4, lines 56-58).

In view of the above, the Applicant submits that since claims 1-5 of U.S. Patent No. 6,099,203 and the reference of Ebinger each do not teach the above features of Applicant's independent claims 1 and 8 and since claims 1-5 of U.S. Patent No. 6,099,203 and the reference of Ebinger each teaches away from the reference of Stuart, the Applicant submits that it would not have been obvious to combine the teachings of claims 1-5 of U.S. Patent No. 6,099,203 and Stuart, and Ebinger to reject Applicant's claims 8-9 and 11-12 under the judicially created doctrine of obviousness-type double patenting.

Applicant's claimed subject matter is patentably distinct
From the subject matter of claims 1-5 of Landes '203

In further regards to the office's rejection of the Applicant's claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 (Landes) in view of Stuart (US Patent No. 6,461,084) and

further in view of Ebinger (U.S. Patent No. 3,709,112), in the case of *In re Goodman*, the Federal Circuit held:

“To prevent extension of the patent right beyond statutory limits, the doctrine of obviousness-type double patenting rejects application claims to subject matter different but not patentably distinct from the subject matter claimed in a prior patent. . .

The double patenting determination involves two inquiries. First, is the same invention claimed twice? . . . This inquiry hinges upon the scope of the claims in question. . . . If the claimed inventions are identical in scope, the proper rejection is under 35 U.S.C. § 101 because an inventor is entitled to a single patent for an invention. . . .

If one claimed invention has a broader scope than the other, the court must proceed to a second inquiry: whether one claim defines merely an obvious variation of the other patent claim. . . . Without a patentable distinction—because the pending claim defines merely an obvious variation of the patented claim—the patentee may overcome the double patenting rejection by filing a terminal disclaimer. (Emphasis added, see *In re Goodman*, 29 USPQ 2d 2010, 2015–16 (Fed. Cir. 1993))

In view of *In re Goodman*, it is respectfully submitted that the present application is not an attempt on an extension of the patent rights of U.S. patent 6,099,203 beyond its statutory limits as the Applicant's claimed subject matter is not a mere obvious variation of claims 1-5 of U.S. patent 6,099,203. The Applicant's claimed subject matter instead is patentably distinct from claims 1-5 of U.S. patent 6,099,203 as Applicant's independent claims 1 and 8 each call for a hollow anchoring marker post that includes the features of the “integral anchoring flaps” and the “flexible living hinges,” which are not found in claims 1-5 of U.S. Patent 6,099,203. Further note that Applicant's independent claims 1 and 8 does not include the feature of the integral webs as called for in claims 1-5 of U.S. patent 6,099,203.

In further regards to the Applicant's dependent claims 2-6, 9 and 11-12, Applicant's claims 2-6 each depends on Applicant's independent claim 1. Since Applicant's independent claim 1 is

allowable for the reasons given above, Applicant's dependent claims 2-6 should also be allowable. Applicant's dependent claims 9 and 11-12 each depend on Applicant's independent claim 8. Since Applicant's independent claim 8 is allowable for the reasons given above, Applicant's dependent claims 9 and 11-12 are also allowable.

In view of the above, it is submitted that the applicant is in condition for allowance.

Allowance of claims 1-6 and claims 8-9 and 11-12 is respectfully requested. Applicant has enclosed a version of the currently pending claims with the present response.

In view of the above, it is submitted that the applicant is in condition for allowance.

Allowance of claims 1-6, 8, 9 and 11-12 is respectfully requested. Applicant has enclosed a version of the amended claims showing changes made with this response.

Respectfully submitted,

JACOBSON AND JOHNSON

By 

Carl L. Johnson, Reg. No. 24,273
Attorneys for Applicant
Suite 285

One West Water Street
St. Paul, Minnesota 55107-2080
Telephone: 651- 222-3775
Fax: 651-222-3776

CLJ/cj
Enclosure